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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,241	02/20/2002	Patrice Duvert	022650-621	5583

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/078,241

Applicant(s)

DUVERT, PATRICE

Examiner

Alton N. Pryor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating a fungi, does not reasonably provide enablement for preventing or curing fungi on plants. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make / use the invention commensurate in scope with these claims. The asserted utility is not believable on its face. It is not known how a method wherein a composition is claimed can be administered to prevent or cure fungal disease. The state of the art is what prior art knows about the invention. There is no known art wherein a certain composition is administered to successfully prevent or cure fungal growth on plants. The level of ordinary skill in the art is high but only in the art of treating said fungal growth. The predictability or lack thereof in the art refers to the ability of one skilled in the art to extrapolate the disclosed or known results to the claimed invention. The lower the predictability, the higher the direction and guidance that must be provided by the applicant. In the instant invention the predictability is very low and consequently,

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the need for the higher levels of direction and guidance by the applicant. However, the amount of direction and guidance provided by the applicant is limited to treatment.

There is no evidence in the specification that established correlation between the experiment and the claimed utility. The quantity of experimentation required to use the method as claimed in the instant invention, based on applicant's disclosure would be undue because, one of ordinary skill in the art would have performed significant amount of experiments.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-20,23,24 are rejected under 35 U.S.C. 102(e) as being anticipated by Oguri (US 6518304; 2/11/03). Oguri teaches a fungicidal composition comprising 5 parts formula Ia (BAS 490F) plus 5 parts iprodione (1:1). Oguri teaches a fungicidal composition comprising 5 part formula Ie (SSF-129) and 5 part iprodione (1:1). See column 8 Formulation Example 8. Oguri teaches a fungicidal composition comprising 1 parts formula Ia (BAS 490F) plus 5 parts iprodione (0.2). Oguri teaches a fungicidal

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composition comprising 1 part formula Ie (SSF-129) and 5 part iprodione (0.2). See column 8 Formulation Example 7. Oguri teaches that the fungicidal composition can be present in a liquid or solid carrier along with a surfactant (surface active agent). See column 6 lines 43-51. Oguri teaches that the composition is applied to plants to control fungal growth at a rate of 0.001 to 1000 g / are. See column 7 lines 32-43.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latrose (WO 9603044; 2/8/96), the US equivalent is USPN 5,906,986. Latrose teaches a fungicidal composition comprising a 2-imidazoline-5-one compound plus at least one additional fungicide. The additional fungicides include the instant iprodione (compound B), BAS 490F (compound A), and SSF 129 (compound A). Latrose teaches that the fungicidal composition can be present in a liquid or solid carrier along with a surface active agent. Latrose teaches that the composition is applied to plants to control fungal growth at a rate of 10 to 5000 g/ha. See WO' 044 abstract. See US '986 abstract, column 2 lines 2, 11-16, column 7 lines 55-65. Latrose differs from the prior art in that Latrose does not exemplify an invention comprising iprodione and BAS 490F or iprodione and SSF 129. Latrose also does not teach the instant ratios and application rates of ingredients. Because Latrose teaches that the additional compounds included

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in the composition is at least one of iprodone, SSF-129, and BAS-490F, it would have been obvious to one having ordinary skill in the art to develop an invention comprising iprodone plus SSF-129 or iprodone plus BAS-490F or iprodone plus SSF0-129 plus BAS-490F. One would have been motivated to do this because Latrose suggests the combination. With respect to the instant ratios of ingredients, one having ordinary skill in the art would have been expected to determine the optimum ratios through routine experimentation. One would have been motivated to do this in order to enhance the effectiveness of the invention at controlling fungal growth on plants. With respect to the application rates the prior art range (10-5000 g/ha of composition) overlaps the instant application rate range (150-7000 g/ha of composition). It is very possible the optimum application rate of the composition would have fallen at a point where the two (prior art and instant application) application rate ranges overlap.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 703 308-4691. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-3592 for regular communications and 703-305-3592 for After Final communications.